



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,125	04/19/2000	Joseph M. Cannon	1298/OF148	3933

7590 06/14/2006  
WILLIAM H. BOLLMAN  
MANELLI DENISON & SELTER PLLC  
2000 M STREET, NW  
SUITE 700  
WASHINGTON, DC 20036-3307

EXAMINER

GAUTHIER, GERALD

ART UNIT PAPER NUMBER

2614

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/553,125

**Applicant(s)**

CANNON ET AL.

**Examiner**

Gerald Gauthier

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claim(s) 1** is rejected under 35 U.S.C. 102(e) as being anticipated by Burg (US 2002/0090064 A1).

Regarding **claim(s) 1**, Burg discloses a method for communicating an audio message from a calling telephone apparatus to a called telephone apparatus while the called telephone apparatus remains in an on-hook state, the calling telephone apparatus and the called telephone apparatus being connected to a telephone system (FIG. 1 and paragraph 0002), the method comprising the steps of:

receiving a telephone call at a called telephone apparatus from said calling telephone apparatus (paragraph 0020); and

introducing a digitized version of said audio message relating to a call from said calling telephone apparatus over a telephone line to said called telephone apparatus while said telephone line of said called telephone apparatus remains in said on-hook state (paragraph 0028).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claim(s) 2-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Burg in view of Guercio et al. (US 6,373,925 B1).

Regarding **claim(s) 2, 5, 8 and 11**, Burg as applied to **claim(s) 1, 4, 7 and 10** differ from **claim(s) 2, 5, 8 and 11** in that it fails to disclose a signal identifying the calling party during a silent interval following a first ringing signal provided to the called telephone apparatus, whereby the called telephone apparatus is provided Caller ID information, in addition to the audio message.

However, Guercio teaches introducing a signal identifying the calling party (column 7, line 56 “the calling party information”) during a silent interval (column 7, line 57 “between a first ring signal and a second ring signal”) following a first ringing signal (column 7, line 57 “a first ring”) provided to the called telephone apparatus, whereby the called telephone apparatus is provided Caller ID information, in addition to the audio message (column 7, lines 50-67) [The caller ID information is transmitted between the first and the second ringing cycles and the associated voice message is played back].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Burg using the calling party announcement system as taught by Guercio.

This modification would enable the system to improve a telephone answering method so that the user would receive the caller ID information before answering the call.

Regarding **claim(s) 3, 6, 9 and 12**, Guercio teaches wherein the digitized version of the audio message is of sufficient duration to extend beyond a silent interval in which

it begins (column 7, lines 50-67) [The store voice message may also be playback in place of subsequent ring signals].

Regarding **claim(s) 4, 7 and 10**, Burg discloses all the limitations of **claim(s) 7** as stated in **claim(s) 1**' rejection above but fails to disclose detecting a silent interval following a second ringing signal.

However Guercio teaches a silence detector detecting a silent interval following a second ringing signal provided to the called telephone apparatus (column 7, lines 50-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Burg using the teaching of calling party announcement system as taught by Guercio.

This modification would enable the system to improve a telephone answering method so that the user would receive the caller ID information before answering the call.

### ***Response to Arguments***

7. Applicant's arguments with respect to **claim(s) 1-12** have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**GERALD GAUTHIER**  
**PATENT EXAMINER**

Gerald Gauthier  
Examiner  
Art Unit 2614

GG  
June 7, 2006